

55. (New) A telephony connection server comprising:

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a call management function operable to receive a request to initiate a telephone call using at least one voice communications device, and to send a response message in response to the request message;

the call management function operates using a call management protocol selected from the group of protocols consisting of: the Session Initiation Protocol (SIP), the H.323 protocol, the MGCP protocol and the MEGACO protocol;

a network telephony user database to store a user identifier for each of a plurality of users, wherein the user identifier includes a first sequence of alphanumeric elements that identify a user of a voice communications device; and

an advertisement service to retrieve at least one commercial message from a commercial message server and to communicate the commercial messages in the response message.

56. (New) The telephony connection server of Claim 55 wherein the commercial message is communicated in a SIP response message.

57. (New) The telephony connection server of Claim 55 wherein the telephony connection server is operable to send the request to initiate the telephone call to a callee party at a second voice communications device, and wherein:

the commercial message is communicated in the request to initiate.

REMARKS

In the Office Action mailed September 17, 2001, the Examiner (i) objected to claims 17, and 48-50 as being dependent upon a rejected base claim, (ii) rejected claims 1-2, 9-10, 20, 22-23, 26-30, 36-38, 41-43, 45, 47, and 51-53 under 35 U.S.C. §102(e), and (iii) rejected claims 3-8, 11-16, 18-19, 21, 31-35, 39-40, 44, and 46 under 35 U.S.C. §103(a). Claims 1, 20, 26, 30, 41, 51, 52, and 53 have been amended solely for purposes of clarifying the claims. In addition,

claims 17, and 48-50 have been cancelled, and new claims 54-57 have been added. Applicants have reviewed the Examiner's remarks and the cited references and respectfully submit that the cited references fail to teach or suggest all of the elements of Applicants' presently claimed invention. Therefore, Applicants respectfully traverse the rejections and request favorable reconsideration in view of the following remarks.

Claim Objections

The Examiner objected to claims 17, and 48-50 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants would like to thank the Examiner for noting that claims 17, and 48-50 contain allowable subject matter. Applicants have adopted the suggestion of the Examiner to present claims 17, and 48 in independent form. Claims 17, and 48-50 have been cancelled and replaced by newly independent claims 54-55 and newly dependent claims 56-57. Applicants respectfully submit that the added claims are supported by the specification as originally filed and no new matter has been added. Applicants submit that claims 54-57 are allowable.

Claim Rejections – 35 U.S.C. §102(e)

Rejections under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,999,965

The Examiner rejected claims 1-2, 9-10, 20, 22-23, 26-30, 36-38, 41-43, 45, 47, and 51-53 under 35 U.S.C. §102(e) as being anticipated by Kelly, U.S. Patent Number 5,999,965 (hereinafter Kelly).

Kelly discloses an Automatic Call Distribution (ACD) server 500. A caller initiates a connection to a connection server 510. In response, connection server 510 transmits a

CONNECTACK packet to the caller. A connection is made between a caller and the connection server 510 which communicates with the ACD server 500. If queues within ACD server 500 are not full, ACD server 500 places the call on queue for servicing by an agent 530. While a call is in queue, i.e. on hold, ACD server 500 may transmit periodic audio messages such as "Please wait for next available agent or press 1 to request callback," and/or other information such as music, advertisements, stock quotes, etc. When an agent is available, the call is transferred to the agent and a transfer of multiple AUDIO packets between agent 530 and the caller follows. The connection between ACD server and the caller terminates once the call is transferred to the agent 530. (Kelly, Col. 15 line 54 – Col. 17 line 4). Kelly further states that an "agent may transmit a 'Non-ACD' status packet indicating that the agent has initiated a call and is unavailable to receive customer calls." (Kelly, Col. 19, lines 33-34). The Non-ACD status disables the ACD server, disabling the transmission of periodic audio advertisement messages, in order to allow the agent to communicate with a caller. (Kelly, Col. 20, lines 30-40). Kelly also states that "[t]he ACD server can be programmed to replay specific recordings at regular intervals, or greetings when a call is first received." (Kelly, Col. 21, lines 32-34). The announcements are initial messages that take place prior to an agent communicating with the caller.

With respect to the Examiner's rejections of claims 1-2 and 9-10, the Examiner asserts that Kelly teaches a system for providing advertising on a data network telephony system. Applicants respectfully submit that Kelly does not teach a commercial message server operable to send at least one commercial message, and that a first data network telephone is operable to receive the commercial messages while communicating voice signals as data packets. Kelly teaches that an ACD server 500 may transmit advertisements to a caller while the caller is on hold over an ACD server connection with the caller. Subsequently, when the caller is taken off

hold and connected with an agent for voice communication, the ACD server connection is terminated. Therefore, Kelly teaches that the ACD server 500 cannot transmit advertisements to the caller while the caller is connected to an agent for voice communication. (Kelly, Col. 20, lines 30-40). Consequently, Kelly does not teach a first data network telephone operable to receive commercial messages while communicating voice signals as data packets as in presently pending claim 1 and subsequently in dependent claims 2 and 9-10. ✓

With respect to the Examiner's rejection of claims 20, 22-23, 26-30, 36-38, 41-43, 45, and 53, the Examiner asserts that Kelly teaches a method for advertising on a telephony system. Applicants respectfully submit that Kelly does not teach receiving at least one commercial message at the first data network telephone while the first data network telephone is communicating voice signals as data packets as in presently pending independent claim 20 and similarly in independent claims 26, 30, 41, and 53. Kelly does not anticipate independent claims 20, 26, 30, 41, and 53 for the same reasons stated above with respect to claim 1, and therefore Kelly does not anticipate dependent claims 22-23, 27-29, 36-38, 42-43 and 45. ✓

With respect to the Examiner's rejections of claims 47, 51 and 52, the Examiner asserts that Kelly teaches a telephony connection server. Applicants respectfully submit that Kelly does not teach a call management function operable to receive a request to initiate a call and send a response message in response to the request, and an advertisement service to retrieve at least one commercial message from a commercial message server and to communicate the commercial messages in the response message. In contrast, Kelly teaches that a "caller process 520 transmits to connection server 510 a CONNECTREQ package, and in response, connection server 510 transmits a CONNECTACK packet to caller process 520." (Kelly, Figure 5 and Col. 15, lines

60-67). Kelly does not teach or disclose to communicate commercial messages in the response message as in presently pending claims 47, 51 and 52.

Rejections under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,285,364

The Examiner also rejected claims independent claims 24-25 under 35 U.S.C. §102(e) as being anticipated by Giordano, III et al., U.S. Patent Number 6,285,364 (hereinafter Giordano).

As to claims 24-25, the Examiner asserts that Giordano teaches a method for programming at least one speed dial key on a voice communications device. Applicants respectfully submit that Giordano does not disclose “receiving a commercial message having a speed dial key program having a selected user identifier,” or “assigning the selected user identifier to the speed dial key,” as in presently pending claims 24-25. In contrast, Giordano discloses a computer telephone having a slide-up window interface, which initiates during a telephone call. The slide-up window includes speed dial numbers that may be displayed when a call is initiated. (Giordano, Col. 5, lines 35-39). Giordano discloses that a speed dial key on the window can be assigned an animated GIF as its icon. (Giordano, Col. 7, lines 24-26). Giordano does not disclose receiving a commercial message having a speed dial key program. Giordano teaches conventional telephone speed dial key programming and usage on a computer-based telephone. Furthermore, Giordano only teaches conventional telephone calling. Giordano fails to teach or disclose commercial messaging.

Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected claims 3-7 and 31-34 under 35 U.S.C. §103(a) as being unpatentable over Kelly in view of Giordano. The Examiner also rejected claims 8 and 35 under 35 U.S.C. §103(a) as being unpatentable over Kelly in view of Giordano, and further in view of

Oran, U.S. Patent Number 6,275,574 (hereinafter Oran). Oran teaches a dial plan mapper to efficiently route calls between different destinations for phones. Oran does not disclose communicating commercial messages to data network telephones. Neither Kelly, Giordano, nor Oran separately or in combination, teach or suggest all elements of claims 3-8 and 31-35 for the same reasons stated above with respect to claims 1 and 30. Applicants respectfully submit that neither Kelly, Giordano, nor Oran teach or suggest, separately or in combination, receiving at least one commercial message at the first data network telephone while the first data network telephone is communicating voice signals as data packets. Consequently, Applicants submit that the Examiner has not established a *prima facie* case of obviousness of claims 3-8 and 31-35.

The Examiner also rejected claims 11-16, 18-19, 39-40, and 44 under 35 U.S.C. §103(a) as being unpatentable over Kelly in view of Oran. Applicants respectfully submit that neither Kelly nor Oran teach or suggest, separately or in combination, a first data network telephone operable to receive commercial messages while communicating voice signals as data packets. Neither Kelly nor Oran, separately or in combination, teach or suggest all elements of claims 11-16, 18-19, 39-40, and 44 for the same reasons stated above with respect to claims 1, 30, and 41. Consequently, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of claims 11-16, 18-19, 39-40, and 44.

The Examiner also rejected claims 21 and 46 under 35 U.S.C. §103(a) as being unpatentable over Kelly in view of Marino et al., U.S. Patent Number 4,850,007 (hereinafter Marino). Applicants respectfully submit that neither Kelly nor Marino, separately or in combination, teach or suggest a data network telephone operable to receive commercial messages while communicating voice signals as data packets. Neither Kelly nor Marino, separately or in combination, teach or suggest all elements of claims 21 and 46 for the same

reasons stated above with respect to claims 20 and 41. Consequently, Applicants respectfully submit that Examiner has not established a *prima facie* case of obviousness of claims 21 and 46.

Summary:

Applicants respectfully submit that, in view of the remarks above, the present application, including claims 1-16, 18-47, and 51-57, is now in condition for allowance and solicit action to that end.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,

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APPENDIX A

Marked-up version of the claims indicating amendments where deletions are shown by brackets and additions are shown by underlining:

1. (Amended) A system for providing advertising on a data network telephony system comprising:

a data network to provide data connectivity for a plurality of data communications channels using data transport protocols;

a commercial message server connected to the data network, the commercial message server being operable to send at least one commercial message;

a first and second data network [telephones] telephone connected to the data network, each data network telephone operable to communicate voice signals as data packets on a voice over data channel, the voice over data channel being one of the plurality of data communications channels on the data network containing packetized voice signals, the data network telephones being operable to convert data packets communicated on the voice over data channel to voice; and

the first data network telephone being operable to receive the commercial messages while communicating voice signals as data packets, the first data network telephone further comprising a message display device to display the commercial messages.

20. (Amended) A method for advertising on a telephony system, the method comprising the steps of:

receiving a request to initiate a telephone call between a first data network telephone to a second data network telephone over a data network, the first and second data network telephones having a display screen, the request containing a caller user identifier to identify a first user of the first data network telephone, and a callee user identifier to identify a user of the second data network telephone;

retrieving at least one commercial message from a commercial message server;
[and]

sending the at least one commercial message to the first data network telephone[.]; and

receiving the at least one commercial message at the first data network telephone while the first data network telephone is communicating voice signals as data packets.

26. (Amended) A method of providing advertising services comprising the steps of:
storing at least one merchant commercial in a commercial message database;
communicating with a telephony service provider to receive connection information, the connection information including at least a user identifier corresponding to a user of a data network telephone;

sending at least one commercial message to the data network telephone while the data network telephone is communicating voice signals as data packets; and
displaying the commercial message at the data network telephone.

30. (Amended) A voice communications device comprising:
a network interface to communicate using at least one data communications channel over a data network, the data communications channel including at least one voice over data communications channel;

a voice over data processor to convert voice signals to voice over data signals, and to convert voice over data signals to voice signals, the voice over data signals being communicated on the voice over data communications channel;

a signaling stack to send a request to initiate a telephone call and to send a response to a received request to initiate a telephone call from another voice communications device; and

a message display device to display at least one commercial message received over the data network while the voice communications device is communicating the voice over data signals on the voice over data communications channel.

41. (Amended) A commercial message server comprising:
at least one commercial message for display on a voice communications device;

[an] a telephony connection server interface to receive [a] connection information from a telephony connection server, the connection information comprising at least one user identifier for at least one party to a telephone call, the at least one party using the voice communications device to initiate the telephone call; and

the commercial message server being operable to send the commercial message to the voice communications device in use by the at least one party identified by the user identifier while the at least one party is communicating voice signals over the voice communications device.

51. (Amended) A telephony connection server comprising:

a call management function operable to receive a request to initiate a telephone call between at least two voice communications devices, and to send a response message in response to the request message;

a network telephony user database to store a user identifier for each of a plurality of users, wherein the user identifier includes a first sequence of alphanumeric elements that identify a user of a voice communications device; and

an advertisement service to send a connection information message having a user identifier that identifies at least one of the parties to a commercial message server, wherein the commercial message server uses the connection information message to send a commercial message in the response message to the user identifier.

52. (Amended) A telephony connection server comprising:

a call management function operable to receive a request to initiate a telephone call between at least two voice communications devices, and to send a response message in response to the request message;

a connection to a commercial message server to send at least one commercial message in response to a request for a commercial message;

a network telephony user database to store a user identifier for each of a plurality of users, wherein the user identifier includes a first sequence of alphanumeric elements that identify a user of the voice communications device; and

an advertisement service to retrieve at least one commercial message from the commercial message server, the network telephony connection server being operable to initiate a selected data communications channel and to send the commercial messages in the response message to at least one of the voice communications devices.

53. (Amended) A memory for storing commercial messages comprising:

a merchant record for identifying a merchant corresponding to the commercial messages; and

a connection to a data network to transport the commercial messages to a plurality of voice communications devices while the plurality of voice communications devices are communicating voice signals as data packets.